



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/808,421	03/13/2001	Anthony Angelo Agoni	ALAW.001A	3477

20995 7590 11/27/2006

KNOBBE MARTENS OLSON & BEAR LLP
2040 MAIN STREET
FOURTEENTH FLOOR
IRVINE, CA 92614

EXAMINER

BLECK, CAROLYN M

ART UNIT PAPER NUMBER

3626

DATE MAILED: 11/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/808,421	Applicant(s) AGONI ET AL.	
	Examiner Carolyn M. Bleck	Art Unit 3626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 September 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6, 74 and 75 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 and 74-75 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Notice to Applicant

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11 September 2006 has been entered.
2. This communication is in response to the RCE filed on 11 September 2006. Claims 1-6 and 74-75 are pending. Claims 1, 3-5, 74, and 75 have been amended. Claims 7-73 and 76-78 have been cancelled.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-6 and 74 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rizzo et al. (6,470,338) in view of Shubov et al. (US 2002/0038233 A1) and Johnson et al. (5,964,839).

Art Unit: 3626

(A) As per claim 74, Rizzo discloses a system for matching potential clients with professional services providers which meet their personalized criteria comprising

(Abstract):

(a) means for identifying via a webpage a service provider (Fig. 3, col. 2 lines 49-65, col. 9 lines 18-42, col. 10 lines 7-43);

(b) means for receiving data entered by potential clients using data entry devices, said received data being indicative of criteria, and automatically comparing said received data to data stored in a storage medium to identify one or more suitable professional services providers based upon said criteria (Fig. 1B, col. 3 line 59 to col. 4 line 32, col. 6 lines 5-53, col. 9 lines 18-42, col. 10 lines 7-43); and

(c) means for receiving a response from at least one responding identified service provider, wherein the response is in reply to the clients request (Fig. 1C, 7, col. 7 line 39 to col. 8 line 51), wherein the service provider has signed up with the system for a membership fee and the client is able to use the system to access information about the service provider (reads on "agreement to use a communication-enhancing system") (col. 3 line 59 to col. 4 line 21) (As per the limitation of "a computer-based" communication-enhancing system, Rizzo discloses requiring an attorney to enter a User ID and password to enter the system, wherein the user is then able to email the clients through the system (Fig. 1C, 7, col. 3 line 59 to col. 4 line 11, col. 7 line 39 to col. 8 line 26). It is noted that entering a user ID and password into a system and then using that system to send emails to the client is considered to be a form of "receiving an agreement from said service provider to user a computer-based communication-

Art Unit: 3626

enhancing system to provide services to the client.” Further, it is noted that submitting a user ID and password to email clients is an agreement because the only way for the attorney to email the client is to “agree” to use the system by submitting a user ID and password. Without the submission of this information, the user is unable to gain access to the computer-based system to provide services (i.e., email) to the client.).

Rizzo does not expressly disclose a means for receiving an agreement from at least one client to use said service provider to provide services and a means for monitoring by the computer-based service-enhancing system a frequency of communications between said service provider and said at least one client during the time that services are provided to said at least one client.

Shubov discloses a means for transmitting an acceptance of a bid to an attorney computer (par. 153, page 13, col. 2 claims 15-18) and a means for tracking consumers and attorneys use of the matching system (par. 167-168).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to include the features of Shubov within the system of Rizzo with the motivation of allowing service providers and consumers to easily communicate about the services (Shubov; par. 6).

Rizzo and Shubov do not expressly disclose specifically monitoring the frequency of the communications between the provider and the client during the time the services are provided to the client.

Johnson discloses monitoring the frequency of the communications between the provider and the client during the time the services are provided to the client (i.e.,

Art Unit: 3626

monitoring the real-time interaction between a service and a user, wherein the data collected includes the type of service and the type and number of inquiries made (reads on "frequency of the communications")) (col. 2 line 43 to col. 3 line 18, col. 3 lines 37-59, col. 4 lines 49-60, col. 15 lines 9-21).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to include the features of Johnson within the system taught collectively by Rizzo and Shubov with the motivation of monitoring communications between a service provider and a customer (Johnson; col. 1 lines 18-54).

(B) As per claims 1-2, Rizzo discloses a method for matching potential clients with professional service providers comprising:

(a) generating email messages to send to a client identifying a service provider (col. 7 lines 20-38);

(b) accessing by the client the email messages having information about potential service providers (col. 7 lines 20-38);

(c) receiving a response from at least one responding identified service provider, wherein the response is in reply to the clients request (Fig. 1C, 7, col. 7 line 39 to col. 8 line 51), wherein the service provider has signed up with the system for a membership fee and the client is able to use the system to access information about the service provider (reads on "agreement to use a first service-enhancing system") (col. 3 line 59 to col. 4 line 21); and

Art Unit: 3626

(d) performing steps a-c by a second service provider, wherein the second service provider is not a registered member (reads on "using a second service-enhancing system having at least one feature absent from the first service-enhancing system (col. 7 lines 19-67).

The remaining features of claims 1 and 2 repeat the limitations of claim 74, and are thus rejected for the same reasons given for claim 74.

(C) As per claim 3, Rizzo discloses a system for matching potential clients with professional services providers which meet their personalized criteria comprising (Abstract):

(a) identifying via a webpage a service provider (Fig. 3, col. 2 lines 49-65, col. 9 lines 18-42, col. 10 lines 7-43);

(b) receiving data entered by potential clients using data entry devices, said received data being indicative of criteria, and automatically comparing said received data to data stored in a storage medium to identify one or more suitable professional services providers based upon said criteria (Fig. 1B, col. 3 line 59 to col. 4 line 32, col. 6 lines 5-53, col. 9 lines 18-42, col. 10 lines 7-43); and

(c) providing by the service provider, such as a law firm or attorney, information about themselves including jurisdictions in which they practice, areas of expertise, size of the law firm, and email address (col. 3 line 59 to col. 4 line 11), wherein the service provider submits a response in reply to the clients request (Fig. 1C, 7, col. 7 line 39 to col. 8 line 51), wherein the service provider has signed up with the system for a

Art Unit: 3626

membership fee and the client is able to use the system to access information about the service provider (reads on "agreement") (col. 3 line 59 to col. 4 line 21); and

Rizzo does not expressly disclose a means for receiving an agreement from at least one client to use said service provider to provide services and a means for monitoring by the computer-based service-enhancing system a frequency of communications between said service provider and said at least one client during the time that services are provided to said at least one client.

Shubov discloses a means for transmitting an acceptance of a bid to an attorney computer (par. 153, page 13, col. 2 claims 15-18) and a means for tracking consumers and attorneys use of the matching system (par. 167-168).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to include the features of Shubov within the system of Rizzo with the motivation of allowing service providers and consumers to easily communicate about the services (Shubov; par. 6).

Rizzo and Shubov do not expressly disclose specifically monitoring the frequency of the communications between the provider and the client during the time the services are provided to the client.

Johnson discloses monitoring the frequency of the communications between the provider and the client during the time the services are provided to the client (i.e., monitoring the real-time interaction between a service and a user, wherein the data collected includes the type of service and the type and number of inquiries made (reads

on “frequency of the communications”)) (col. 2 line 43 to col. 3 line 18, col. 3 lines 37-59, col. 4 lines 49-60, col. 15 lines 9-21).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to include the features of Johnson within the system taught collectively by Rizzo and Shubov with the motivation of monitoring communications between a service provider and a customer (Johnson; col. 1 lines 18-54).

Rizzo, Shubov, and Johnson do not expressly disclose means for receiving an agreement from said service provider to communicate with said at least one of said potential clients in accordance with a predetermined communication frequency while providing services. However, it is well known in the legal profession that a service provider, such as a lawyer, has a duty to communicate with a client. (See Model Rules of Professional Conduct, Rule 1.4). The lawyer must keep a client reasonably informed about the client’s matter and must promptly comply with reasonable requests for information. Thus, it is well known that lawyers and clients agree to a “predetermined communication frequency” (i.e., that a lawyer will communicate frequently with the client) when a lawyer agrees to work on a client’s matter. The motivation for including this modification within the system taught collectively by Rizzo, Thompson, and Shubov with the motivation of ensuring the client is informed about the client’s matter.

(D) As per claims 4 and 6, the Examiner notes that Rizzo discloses providing by the service provider, such as a law firm or attorney, information about themselves including jurisdictions in which they practice, areas of expertise, size of the law firm, and email

Art Unit: 3626

address (col. 3 line 59 to col. 4 line 11), wherein the service provider submits a response in reply to the clients request (Fig. 1C, 7, col. 7 line 39 to col. 8 line 51), wherein the service provider has signed up with the system for a membership fee and the client is able to use the system to access information about the service provider (reads on "agreement") (col. 3 line 59 to col. 4 line 21). Rizzo does not disclose the agreement being to use a computer-software based process to assure that said service provider adheres to certain standards of care or the agreement from said service provider being to not pass on to any client any cost of using said computer software-based process. However, the differences between Rizzo and the prior art are only found in the nonfunctional descriptive material and are not functionally involved in the step recited. The step of receiving an agreement would be performed the same regardless of the terms of the agreement. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994). For further guidance, note MPEP § 2106, common situations involving nonfunctional descriptive material are: "a process that differs from the prior art only with respect to nonfunctional descriptive material that cannot alter how the process steps are to be performed to achieve the utility of the invention."

(E) As per claim 5, Rizzo discloses a service provider paying a membership fee (col. 3 line 65 to col. 4 line 5).

5. Claim 75 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rizzo et al. (6,470,338) in view of Thompson et al. (6,334,133) and Shubov et al. (US 2002/0038233 A1) and Official Notice.

(A) As per claim 75, Rizzo discloses a system for matching potential clients with professional services providers which meet their personalized criteria comprising (Abstract):

(a) means for identifying via a webpage a service provider (Fig. 3, col. 2 lines 49-65, col. 9 lines 18-42, col. 10 lines 7-43);

(b) means for receiving data entered by potential clients using data entry devices, said received data being indicative of criteria, and automatically comparing said received data to data stored in a storage medium to identify one or more suitable professional services providers based upon said criteria (Fig. 1B, col. 3 line 59 to col. 4 line 32, col. 6 lines 5-53, col. 9 lines 18-42, col. 10 lines 7-43); and

(c) means for providing by the service provider, such as a law firm or attorney, information about themselves including jurisdictions in which they practice, areas of expertise, size of the law firm, and email address (col. 3 line 59 to col. 4 line 11).

Rizzo does not explicitly disclose providing by the service provider certain minimum experience requirements, said experience requirements being more specific, or higher than those generally accepted or legally required to practice in the industry of said service provider.

Thompson discloses a replacement worker providing information on their certifications, wherein some of the certifications are more than is needed to teach (Fig. 3, col. 3 lines 5-25, col. 8 lines 15-63).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to include the features of Thompson within the system of Rizzo with the motivation of ensuring that the position is filled by someone who is qualified to take on the role (Rizzo; col. 3 lines 5-25).

Rizzo and Shubov do not expressly disclose means for receiving an agreement from at least one of said potential client to use said service provider to provide services and means for receiving an agreement from said service provider to communicate with said at least one of said potential clients in accordance with a predetermined communication frequency while providing services.

Shubov discloses a means for transmitting an acceptance of a bid to an attorney computer (par. 153, page 13, col. 2 claims 15-18) and a means for tracking consumers and attorneys use of the matching system (par. 167-168).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to include the features of Shubov within the system of Rizzo with the motivation of allowing service providers and consumers to easily communicate about the services (Shubov; par. 6).

Rizzo, Thompson, and Shubov do not expressly disclose means for receiving an agreement from said service provider to communicate with said at least one of said potential clients in accordance with a predetermined communication frequency while

Art Unit: 3626

providing services. However, it is well known in the legal profession that a service provider, such as a lawyer, has a duty to communicate with a client. (See Model Rules of Professional Conduct, Rule 1.4). The lawyer must keep a client reasonably informed about the client's matter and must promptly comply with reasonable requests for information. Thus, it is well known that lawyers and clients agree to a "predetermined communication frequency" (i.e., that a lawyer will communicate frequently with the client) when a lawyer agrees to work on a client's matter. The motivation for including this modification within the system taught collectively by Rizzo, Thompson, and Shubov with the motivation of ensuring the client is informed about the client's matter.

Response to Arguments

6. Applicant's arguments with respect to claims 1-6 and 74-75 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carolyn Bleck whose telephone number is (571) 272-6767. The Examiner can normally be reached on Monday-Thursday, 8:00am – 5:30pm, and from 8:30am – 5:00pm on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached at (571) 272-6776.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


8. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, D.C. 20231

Or faxed to:

(571) 273-8300	[Official communications]
(571) 273-8300	[After Final communications labeled "Box AF"]
(571) 273-6767	[Informal/ Draft communications, labeled "PROPOSED" or "DRAFT"]

Hand-delivered responses should be brought to the Knox Building, Alexandria, VA.


Carolyn M. Bleck
Patent Examiner
Art Unit 3626

10/19/06